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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/595,361

04/12/2006

Tae Il Kim

2017-079

8180

52706

7590

02/20/2008

IPLA P.A.

3580 WILSHIRE BLVD.

17TH FLOOR

LOS ANGELES, CA 90010

EXAMINER

MENEZES, MARCUS

ART UNIT

PAPER NUMBER

3677

MAIL DATE

DELIVERY MODE

02/20/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/595,361	<b>Applicant(s)</b> KIM, TAE IL	
	<b>Examiner</b> Marcus Menezes	<b>Art Unit</b> 3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 10-13 is/are pending in the application.
- 4a) Of the above claim(s) 6-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 10-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                        |                                                                   |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/12/06</u> .                                                 | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION*****Election/Restrictions***

Applicant's election without traverse of "Group I, claims 1-5, and 10-13, drawn to the apparatus" in the reply filed on 11/16/2007 is acknowledged. In a phone call with applicant's representative, Mr. Bame (Reg. No. 44,521), on February 8, 2008, Mr. Bame verified the elected species corresponding to the elected Group I is to Species 1, Figures 4-6. Therefore, claims 6-9 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention and species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 11/16/2007.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5, 11 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, it is unclear whether the Applicant is claiming method of manufacturing an apparatus or an apparatus alone, with regard to the coating process.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3677

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Demott et al. (US Patent Pub. 2003/0129359, hereinafter "Demott").

Regarding claims 1 and 3, Demott discloses micro-prism retroreflective strips (24) having a micro-prism reflective surface on a lower surface thereof; a reinforced fabric (26) (see paragraph 33) attached to the lower surface of the micro-prism retroreflective surface; and a print fabric (22) attached to an upper surface of the micro-prism retroreflective sheet.

As for a printing layer provided on an outer surface of the printed fabric, it would have been obvious to one having ordinary skill in the art to add an extra layer since Demott specifically states that additional layers of material, including fabric may be added "to enhance the fabric design." As for the printed advertisement, indicia is an obvious matter of design choice.

Though the second embodiment of Figure 2 discloses retroreflective strips and not a sheet, the first embodiment in Figure 1 teaches of a retroreflective sheet. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have included the teaching of the sheet in the second embodiment of Demott in order to provide a larger retroreflective surface on the apparatus.

Regarding claim 2, Demott discloses the invention as applied to claim 1 above. Demott further discloses a chemical layer (see paragraph 39) in between an upper surface of the micro-prism retroreflective sheet. As for being applied to said retroreflective sheet, the method of forming the device is not germane to the issue of

Art Unit: 3677

patentability of the device itself. Therefore, this limitation has been given minimal patentable weight.

Regarding claims 4,10 and 12, Demott fails to disclose a transparent film in the second embodiment. However, Demott discloses a transparent coating film (14) in the first embodiment. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have included the transparent coating film covering an outer surface of the printing layer in order "to enhance the fabric design" by providing a protective clear layer.

Claims 5, 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Demott in view of Pricone et al. (US 5,310,436, hereinafter "Pricone").

As best understood by Examiner, Demott discloses the invention as applied to claims 1,2 and 3 above and is not repeated here for brevity, but fails to disclose that the upper and lower surfaces of the micro-prism retroreflective sheet is treated using a UV (ultra-violet) coating process. Pricone teaches of a similar device wherein said retroreflective sheet is treated on an upper surface with a UV (ultra-violet) coating process. (See col. 6, lines 67-68 and col. 7, lines 10-35). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have included said ultra-violet coating process in Demott in view of Pricone in order to provide an outer surface having a poor affinity for paint, allowing the use of solvents to remove paint applied by vandalism and reducing the loss of reflectivity attributed to moisture. As for treating the lower surface with said coating process, it has been held

Art Unit: 3677

that mere duplication of the essential working parts of a device involves only routine skill in the art.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marcus Menezes whose telephone number is (571)272-6284. The examiner can normally be reached on 8:00am - 5:30pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer Gay can be reached on 571-272-7029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Marcus Menezes  
Examiner  
Art Unit 3677

/MM/

/Robert J. Sandy/  
Acting SPE of Art Unit 3677